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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,335	08/04/2003	Jean-Marc DuFour	DRXI-0144	6769
23377	7590	03/08/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103			JONES, DAMERON	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,335

Applicant(s)

DUFOUR, JEAN-MARC

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13, 15-22, 25 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 14, 23, 24 and 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

APPLICANT'S INVENTION

1. Applicant's invention is directed to compounds and uses thereof as set forth in independent claims 1, 9, and 16.

Note: Claims 1-33 are pending.

RESPONSE TO APPLICANT'S ELECTION

2. The restriction requirement has been WITHDRAWN.

DOUBLE PATENTING REJECTIONS

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 16, 19-21, 25, 29, and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,623,721. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims and those of the patented invention are directed to chelating compounds encompassed by independent claim 16. The claims differ in the description of R2 of the patented claims because the instant invention reads on any active group while the patented claims read on isothiocyanate groups. However, a skilled practitioner in the art would recognize that isothiocyanate groups are also active groups. Furthermore, claim 19 which depends upon independent claim 16 discloses isothiocyanate groups.

112 REJECTIONS

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5, 8-13, 15-22, 30, 32, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 (lines 8-9), 8 (line 6), 9 (lines 8-9), 15 (line 6), 16 (lines 7-8), and 22 (line 6): Regarding claims 1, 8, 9, 15, 16, and 22, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 1-5, 8, 9-13, 15, 17-21, and 22: The claims as written are ambiguous because there is no period at the end of the claims. Thus, it is unclear whether Applicant intended to incorporate additional text to the claims.

Claim 16, lines 12 and 13: The claims as written are ambiguous because when Z1 and Z2 are nitrogen, oxygen, or sulfur some of the bonds attaching the variables to the aromatic are missing.

Claim 17, lines 1-2: Did Applicant intend to write 'selected from the group consisting of...' because the use of the term 'comprising' is not acceptable Markush terminology (see MPEP 803.02).

Claim 19: The claim recites the limitation "the isothiocyanato group" in line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claim 20, line 2: Did Applicant intend to insert 'selected from' after the term 'group'.

Claim 21, line 2: The claim as written is confusing because there is a period after 'benzyloxycarbonyl'; however, there is more text in the claim that appears after the period. Thus, it is unclear whether the text after the period should be incorporated into the claim.

Claim 30-33: The claims as written are ambiguous because of the phrase 'animal suspected of having a disease characterized by...tumor cells'. In particular, it is unclear what specific disease/condition Applicant is referring to. However, the specification only discloses tumors and metastases as the 'diseases' for which the instant invention is used. Thus, did Applicant intend to write 'animal having the presence of tumor cells'?

Note: It should be noted that claim 31 is ambiguous because it depends upon claim 30 wherein one cannot readily ascertain what is being claimed.

CLAIM OBJECTIONS

7. Claims 6, 7, 14, 23, 24, and 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

COMMENTS/NOTES

8. It should be noted that no prior art has been cited against the claims of the instant invention; however, Applicant MUST address and overcome the 112 and double patenting rejections. In particular, the claims are distinguished over the instant invention because the prior art of record neither anticipates nor renders obvious the compounds and uses thereof as set forth in independent claims 1, 9, and 16. The closest prior art is Applicant's own work which is cited in the double patenting rejection above.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617.

The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
Art Unit 1616

March 4, 2005